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10/717,922

11/21/2003

Kil-soo Jung

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EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

02/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/717,922

Applicant(s)

JUNG ET AL.

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments, filed 11/26/2007, have been entered and made of record. Claims 1-22 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US PG PUB 2002/0145702 A1) in view of Okada (US PG PUB 2003/0165329).

Regarding claim 1, Kato discloses an information storage medium storing an AV stream to be executed by a reproducing apparatus, the AV stream comprising:

information including information used by the reproducing apparatus to determine a position and attributes related to the AV stream (see paragraphs 0167, 0188, 0194, 0202, 0267, and 0272); and sequence information including information on presentation modes and a presentation time for the files (see fig. 8, paragraphs 0199, 0267 and 0268).

Claim 1 differs from Kato in that the claim further requires at least one still image data clip wherein the at least one still image data clip comprising at least one still image data file.

In the same field of endeavor Okada discloses AV stream, defined as an object, include a variety of AV streams such as still picture data (see paragraph 0087). Okada further discloses the management information has object information for management of recording locations of object and attribute thereof, and PGC which define playback sequence, playback time and so on for the data to be played back from the DVD-RAM (see paragraph 0089). Okada further discloses still picture object information includes still picture stream information, and the still picture general information includes still picture object identification information, still picture object recording time, still object starting and ending number. Okada further discloses the still picture information includes attribute information (see fig. 11 and paragraph 0108 and see also figure 17). Therefore in light of the teaching in Okada it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute Kato's AV stream with Okada AV stream in order to include a plurality of objects.

Regarding claim 2, Okada discloses the at least one still image data clip includes one still image data file having a plurality of still images, and the information on positions of the plurality of still images are start addresses of the plurality of still images (see fig. 16 and paragraphs 0108 and 0142). See also Kato's figs. 8, 11-13 and paragraphs 0223, 0224, and 0241.

Regarding claim 3, Okada discloses the at least one still image data clip includes a plurality of still image data files each having one still image (see 0142), and the information on positions of the still images are file names of the still images (see 0095 and see also Kato's paragraphs 0236, 0267, 0272 and 0279).

Regarding claim 4, Kato discloses playlist including at least one playitem corresponding to a portion of the AV file (see paragraphs 0169 and 0174-0176, see also rejection of claim 1).

Regarding claim 5, Kato discloses wherein the playitem includes information on a start position and an end position of the portion of the AV file (see paragraphs 0224, 0241, 0273, and 0283, see also claim 1 rejection above).

Regarding claim 6, Kato discloses the information storage medium also stores at least one audio data clip including:

at least one audio data file (see paragraphs 0137, 0138 and 0142);

audio clip information including information on a position and attributes of the at least one audio data file (see paragraphs 0339, 0342 and 0345); and

audio sequence information including information on a presentation time for the at least one audio data file (see paragraphs 0331-0332 and 0418).

Regarding claim 7, Kato discloses wherein the presentation time for each of the at least one audio data file is determined using a presentation time stamp according to MPEG standards (see paragraphs 0138, 0209 and 0418).

Regarding claim 8, Kato discloses the presentation time for each of the at least one audio data file is determined by designating a presentation start time and a presentation end time for the at least one audio data file (see paragraphs 0342, 0350 and 0417).

Regarding claim 9, Kato discloses the at least one audio data playlist including at least one audio data playitem corresponding to a portion of the audio data clip (see paragraphs 0146, 0159, 0175, 0176).

Regarding claim 10, Kato discloses the at least one audio data playitem includes information on a start position and an end position of the portion of the audio data clip.

Regarding claim 17, Kato discloses a reproducing apparatus for performing reproduction from an information storage medium storing still image data as clips, comprising: a system clock counter which generates a system clock increasing at each point in time (see paragraphs 0148, 0399 and 0451); a reader which reads information on a presentation time for at least one still image data file (see paragraph 0187 where Kato teaches the thumbnail is a still image), from the information storage medium, the information storage medium including image data clip including the at least one still image data file and information on a presentation mode and the presentation time for the at least one image data file, and then image data which is to be presented within a presentation time corresponding to the system clock (see paragraphs 0155, 0191, 0407 and fig. 1); a video decoder which, when the system clock has a value within a range of the presentation time for the image data, decodes the image data (see fig. 1); and a data output unit which outputs the decoded image data (see fig. 1, paragraphs 0152-0154, 0156 and 0162).

TKG
2/19/08
claim 17
Claim 1 differs from Kato in that the claim further requires at least one still image data clip wherein the at least one still image data clip comprising at least one still image data file.

In the same field of endeavor Okada discloses AV stream, defined as an object, include a variety of AV streams such as still picture data (see paragraph 0087). Okada further discloses the management information has object information for management of recording locations of object and attribute thereof, and PGC which define playback sequence, playback time and so on for the data to be played back from the DVD-RAM (see paragraph 0089). Okada further discloses still picture object information includes still picture stream information, and the still picture general

information includes still picture object identification information, still picture object recording time, still object starting and ending number. Okada further discloses the still picture information includes attribute information (see fig. 11 and paragraph 0108 and see also figure 17). Okada discloses a reproducing apparatus for performing reproduction from an information storage medium storing still image data as clips (see claims 1 and 15), comprising: a system clock counter which generates a system clock increasing at each point in time (see paragraphs 0156, 0182-0186 and 0188); a reader which reads information on a presentation time for each of at least one still image data file (see claim 1 and 15), from the information storage medium. Okada further discloses a video decoder which, when the system clock has a value within a range of the presentation time for the still image data, decodes the still image data (see fig. 18). Therefore in light of the teaching in Okada it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute Kato's AV stream with Okada AV stream in order to include a plurality of objects.

Regarding claim 18, Kato discloses a user inputs one of a Fast Forward command and a Fast Reverse command during presentation of the still image data in a slide show mode, the system clock counter respectively one of decreases and increases the system clock so as to correspond to the presentation time for the still image data (see paragraphs 0157 and 0196).

Regarding claim 19, Kato discloses an audio decoder which, when the system clock has a value within a range of the presentation time for audio data, decodes the audio data (see paragraphs 0143, 0154 and 0156), wherein the information storage medium has stored thereon the audio data as clips (see paragraphs 0339, 0342 and 0345), wherein the reader reads a presentation time for at least one audio data file from the information storage medium, the

information storage medium including an audio data clip including the at least one audio data file and information on a presentation time for the at least one audio data file, and further reads audio data which is to be presented within a presentation time corresponding to the system clock (see paragraphs 0283, 0401 and 0451), and wherein the data output unit outputs the decoded audio data together with the decoded still image data (see paragraphs 0154 and 0156).

Method claims 20-22 are rejected for the same reason as discussed in claims 17-19 respectively above.

5. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US PG PUB 2002/0145702 A1) in view of Okada (US PG PUB 2003/0165329) and further in view of Gadre (US PG PUB 2003/0152371 A1).

Regarding claim 11, the above combination fail to show a presentation mode for the at least one still image data file is one of a slide show mode in which the presentation time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file and a browsable slide show mode in which the presentation time for the at least one still image data file is not synchronized with the presentation time for a corresponding audio data file and a presentation order of the at least one still image data file is changeable when the at least one still image data file is presented.

In the same field of endeavor Gadre discloses a presentation mode for the at least one still image data file is one of a slide show mode in which the presentation time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file and a browsable slide show mode in which the presentation time for the at least one still image data file is not synchronized with the presentation time for a corresponding audio data file and a

presentation order of the at least one still image data file is changeable when the at least one still image data file is presented (see fig. 1 paragraphs 0009 and 0032). Therefore in light of the teaching in Gadre it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the proposed combination by controlling presentation of still images in order to present the images according to user preferences.

Regarding claim 12, Gadre discloses the presentation mode is a slide show mode, and the information on the presentation times for the still images of the at least one still image data file are presentation start times and presentation end times for the still images (see paragraphs 0033, 0035-0036 and 0041, and see also paragraphs 0224, 0273, 0283 in Kato).

Regarding claim 13, Gadre discloses the presentation start times and the presentation end times for the still images are recorded using a presentation time stamp according to MPEG standards (see paragraphs 0009, 0032 and 0033, and see also paragraphs 0381, 0394 and 0400 in Kato).

Regarding claim 14, Gadre discloses the presentation mode is a browsable slide show mode, and the information on the presentation times for the still images of the at least one still image data file are a presentation start time for a first still image and presentation and duration times the still images (see paragraph 0032 and see also paragraphs 0167, and 0194-0196 in Kato).

Regarding claim 15, Gadre discloses the presentation mode for the at least one still image data file is the browsable slide show mode, and the total size of still image clips presented within

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the presentation times for the audio data clips is one of equal to and less than a threshold size (see paragraphs 0033-0035 and see also paragraphs 0243, 0244 and 0280-0281 in Kato).

Regarding claim 16, Kato discloses the threshold size is determined according to the size of a data buffer of a reproducing apparatus (see paragraphs 0389 and 0390).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-16 are still rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. In addition a mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer, and therefore are not statutory. See MPEP 2106.IV.B.1.

In response to the Applicant argument, the amended claims still not overcome the rejection under U.S.C. 101 because the reproduction apparatus is not performing the functions of

any of the limitations recited on the claims but the storage medium and the still image data clip are. The storage medium and the still image clip can still be interpreted as any medium that includes the information cited on the claims. Therefore the rejection is maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

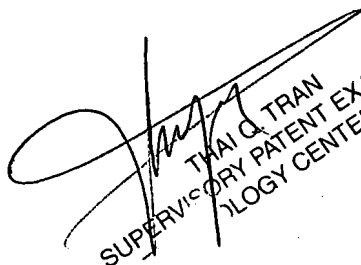
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
February 13, 2008


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